

REMARKS/ARGUMENTS

Claims 1-9 are pending. By this Amendment, claims 1 and 2 are amended, and new claims 3-9 are presented. Support for the amendments to claims 1 and 2 can be found, for example, in original claims 1 and 2. Support for new claims 3-9 can be found, for example, in the present specification at paragraphs [0023], [0024] and [0025] to [0027]. No new matter is added. Claims 1 and 2 are amended solely to improve their clarity. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1 and 2 under 35 U.S.C. §103(a) over U.S. Patent No. 5,047,497 to Tamura et al. ("Tamura"). Applicants respectfully traverse the rejection.

Claim 1 recites "[a] process for producing a polycarbonate, comprising: reacting an aqueous alkali solution of a dihydric phenol with phosgene in the presence of an organic solvent to obtain a polycarbonate oligomer; and polycondensing the polycarbonate oligomer; wherein: reacting the dihydric phenol with phosgene yields an emulsion solution of a polycarbonate oligomer-containing organic solvent; the emulsion solution is subjected to separation in a coalescer to separate the emulsion solution into a polycarbonate oligomer-containing organic solvent phase and an aqueous phase; and polycondensing the polycarbonate oligomer comprises polycondensing polycarbonate oligomer in the polycarbonate oligomer-containing organic solvent phase" (emphasis added). Tamura does not disclose or suggest such a process.

As indicated above, claim 1 requires that an emulsion solution obtained by reacting dihydric phenol with phosgene be separated into a polycarbonate oligomer-containing organic solvent phase and an aqueous phase in a coalescer. The Office Action asserts that it

would have been obvious to employ a coalescer in place of the separation means employed in Tamura. See Office Action, page 4. However, Applicants submit that employing a coalescer is not equivalent employing the means disclosed in Tamura (standing or centrifugal separation – see Tamura, column 7, lines 54 to 58), so one of ordinary skill in the art would not have been motivated to make the substitution proposed in the Office Action. See present specification, paragraph [0004]. By employing the process of claim 1 an emulsion solution containing a polycarbonate oligomer obtained in a polycarbonate oligomer production step is efficiently separated to obtain clean wastewater and to reduce the content of impurity-containing water in the polycarbonate oligomer, which is subsequently used to produce a polycarbonate having excellent quality. See present specification, paragraph [0006]. Tamura does not disclose the particular steps recited in claim 1, or recognize the benefits stemming therefrom. A *prima facie* case of obviousness has not been made.

However, even if a *prima facie* case were made, such case is rebutted by the results shown in the present specification – "[a] *prima facie* case of obviousness ... is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties." See MPEP §2144.09 (citing *In re Papesch*, 315 F.2d 381 (C.C.P.A. 1963)). The Examples of the present specification demonstrate that performing separation using a coalescer, as required by claim 1, provides superior performance (e.g., in water content in organic phase, solids content in aqueous phase, YI value of resulting polycarbonate) in comparison to performing standing separation as provided in Tamura. See, e.g., present specification, paragraphs [0032] to [0036]. These results are objective evidence of the improvements of the process of claim 1 over known processes as in Tamura, and thus these results rebut any suggestion that it would have been obvious to modify the process of Tamura as proposed by the Office Action.

As explained, claim 1 would not have been rendered obvious by Tamura. Claim 2 depends from claim 1 and, thus, also would not have been rendered obvious by Tamura. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

#### New Claims

By this Amendment, new claims 3-9 are presented. New claims 3-9 depend from claim 1 and, thus, are believed to be patentable over the cited reference for at least the reasons discussed above with respect to claim 1.

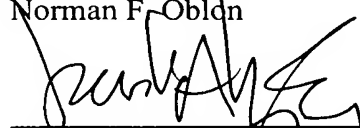
#### Conclusion

For the foregoing reasons, Applicants submit that claims 1-9 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

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